

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

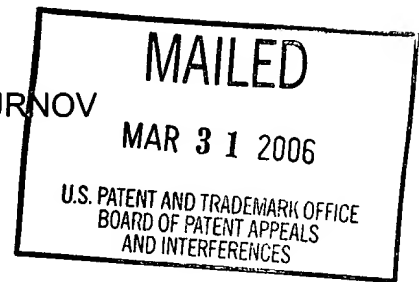
**UNITED STATES PATENT AND TRADEMARK OFFICE**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Ex parte ALAN WOLFFE and FYODOR URNOV

Appeal No. 2006-0765  
Application No. 09/844,501

ON BRIEF



Before ADAMS, MILLS, and GRIMES, Administrative Patent Judges.

MILLS, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of the record leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the examiner to consider the following issues and take appropriate action.

Claims 123-128, 130, 135, 143-145, and 147-151, are pending and on appeal in this application.

Claim 123 is representative and reads as follows:

123. A method for preparing a library of regulatory DNA sequences from a cell, the method comprising:

- (a) providing a cell nucleus, wherein the nucleus comprises cellular chromatin;
- (b) contacting the nucleus with a first enzyme, wherein the first enzyme reacts with accessible regions of cellular chromatin;
- (c) deproteinizing the cellular chromatin to generate deproteinized DNA;

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(d) contacting the deproteinized DNA with a second enzyme to generate DNA fragments;

(e) contacting the DNA fragments obtained in step (d) with a population of vector molecules, wherein the vector molecules comprise a first end that is compatible with the first enzyme and a second end that is compatible with the second enzyme, under conditions favorable to ligation of compatible ends; and

(f) selecting polynucleotides comprising a DNA fragment ligated to a vector molecule.

### Procedural History

A Notice of Appeal was filed by Appellants on August 12, 2004. After the briefing stage the Board determined that the Appeal Brief filed by Appellants was defective and remanded the application to the Examiner on July 12, 2005 to consider a substitute Appeal Brief. The Board also vacated the Examiner's Answer mailed November 17, 2004 and ordered the examiner to submit a revised Examiner's Answer in accordance with newly enacted rules. Subsequently, Appellants filed a Supplemental Brief on August 29, 2005 and the Examiner issued a Supplemental Examiner's Answer on December 5, 2005. In response to the Supplemental Examiner's Answer, Appellants submitted a Reply Brief on February 2, 2006.

The record before us does not reflect that the Reply Brief was made of record in this application, or whether the examiner reviewed and acknowledged entry of the Reply Brief. The application is remanded to the examiner to determine the status of the Reply Brief and whether or not it has been considered by the Examiner.

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This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is not made for further consideration of a rejection, but for an indication of entry of Appellants' Reply Brief. Accordingly, 37 CFR § 41.50(a)(2) does not apply.

REMANDED

  
DONALD E. ADAMS  
Administrative Patent Judge

  
DEMETRA J. MILLS  
Administrative Patent Judge

  
ERIC GRIMES  
Administrative Patent Judge

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